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Practitioner's Docket No. 006565.00002

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Robert C. Heath, Jett E. Stubbs
Application No.: 09/491,094 Group No.: 3727
Filed: 01/24/2000 Examiner: Hylton, Robin
For: DISPOSABLE LID FOR A CUP

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P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION--37 C.F.R. § 41.37)

1. Transmitted herewith, in triplicate, is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on November 9, 2004.
2. STATUS OF APPLICANT

This application is on behalf of a small entity. A statement was already filed.

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CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

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37 C.F.R. § 1.8(a)

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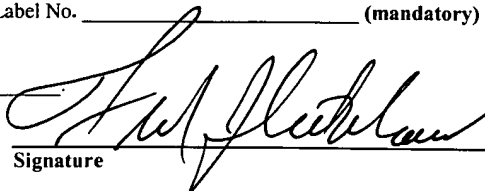
37 C.F.R. § 1.10*

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FRANK J. CATALANO

Date: 1/10/05

(type or print name of person certifying)

* Only the date of filing (' 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under ' 1.8 continues to be taken into account in determining timeliness. See ' 1.703(f). Consider "Express Mail Post Office to Addressee" (' 1.10) or facsimile transmission (' 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 1.17(c), the fee for filing the Appeal Brief is:

small entity \$250.00

Appeal Brief fee due \$250.00

4. EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee \$250.00

Extension fee (if any) \$0.00

TOTAL FEE DUE \$250.00

6. FEE PAYMENT

Authorization is hereby made to charge the amount of \$250.00 to Deposit Account No. 50-1971.

A duplicate of this transmittal is attached.

7. FEE DEFICIENCY

If any additional extension and/or fee is required, and if any additional fee for claims is required, charge Deposit Account No. 50-1971.

Date: 1/10/05



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: ROBERT C. HEATH)
SERIAL NO.: 09/491094)
FILED: 01/24/2000)
FOR: Disposable Lid for a Cup)
DOCKET NO.: 006565.00002)
ART UNIT: 3727)
EXAMINING ATTORNEY: Hylton, Robin)

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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S BRIEF (37 CFR 41.37)

This brief is in furtherance of the Notice of Appeal filed in this case on 11/09/2004.

The fees required under §1.17(f) and any required petition for extension of time for filing this brief and fees therefor are dealt with in the accompanying Transmittal of Appeal Brief.

This brief is transmitted in triplicate.

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this document and any document referred to as being attached therein is being deposited with the U.S. Postal Service in an envelope as "First Class Mail" addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on

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Frank J. Catalano

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This brief contains these items under the following headings and in the order set forth below (37 CFR 41.37(c)):

- I. REAL PARTY INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF CLAIMED SUBJECT MATTER
- VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- VII. ARGUMENT
- VIII. CLAIMS APPENDIX
- IX. EVIDENCE APPENDIX
- X. RELATED PROCEEDINGS APPENDIX

I. REAL PARTY INTEREST (37 CFR 41.37 (c)(1)(i))

The real parties in interest in this appeal are the parties named in the caption of this Brief.

II. RELATED APPEALS AND INTERFERENCES (37 CFR 41.37 (c)(1)(ii))

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal, a previous rejection of the same claims on different grounds was reversed by the Board of Patent Appeals, Appeal No. 2003-0107, dated June 19, 2003 (copy attached in "X. Related Proceedings Appendix.")

III. STATUS OF CLAIMS (37 CFR 41.37(c)(1)(iii))

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

The claims in the application are claims 1-10.

B. STATUS OF ALL THE CLAIMS

1. Claims pending: 1-10.
2. Claims rejected: 1-3.
3. Claims allowed: 4-10.

C. CLAIMS ON APPEAL

Claims 1-3 are on appeal.

IV. STATUS OF AMENDMENTS (37 CFR 41.37 (c)(1)(iv))

All amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER (37 CFR 41.37(c)(1)(v))

Looking at Figure 3 and the specification, p. 6, ln.1-9 and p.6, ln.24-p.7, ln.9, the disposable lid for a cup defined in claim 1 combines an annular clamp 21 adapted to be seated on a rim 15 of the cup C with a spout 23 which extends upwardly from and entirely above the top of the clamp 21 to a discharge port 25 at its apex 27. The clamp 21 has inner and outer lips 61 and 63 which grip the inner and outer walls 13 and 11 of the lip 17 of the cup C inserted therebetween. The inner wall 61 of the clamp and the inner wall 33 of the spout 23 converge smoothly to the discharge port 25.

Continuing to look at Figure 3 and the specification, p.6, ln.9-23, the spout 23 of the disposable lid L is further defined in claims 2 and 3. The spout 23 is frustoconical and has a truncation 37 in the shape of a horizontal plane 39 tangent to a bottom wall of a horizontal cylinder 41. The base inside diameter 43 of the spout 23 is equal to the top inside diameter 45 of the clamp 21 so that the inner wall 61 of the clamp and the inner wall 33 of the spout converge smoothly to the discharge port 25.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
(37 CFR 41.37(c)(1)(vi))

Whether claims 1-3 are unpatentable under 35 U.S.C. § 102 as anticipated by Dvoracek.

Whether claims 2-3 are unpatentable under 35 U.S.C. § 103 over Dvoracek.

VII. ARGUMENT (37 CFR 41.37 (c)(1)(vii))

This patent application was filed on January 24, 2000. Prosecution before the Examiner resulted in rejection of claims 1-3 and allowance of claims 4-10. The Board of Patent Appeals reversed the rejection of claims 1-3 on June 19, 2003. On October 17, 2003, the Examiner reopened prosecution and has finally rejected claims 1-3 on new grounds, resulting in this second appeal.

The reference presently relied upon by the Examiner, U.S. Patent No. 4,961,510, issued to Dvoracek on October 9, 1980, was not cited in this case until prosecution was reopened on October 17, 2003. The Examiner now rejects claims 1-3 under 35 USC § 102 as anticipated by Dvoracek and claims 2-3 under 35 U.S.C. § 103 as unpatentable over Dvoracek.

The rejected claims do not stand or fall together. They may be grouped as follows:

Group A - Claims 1 - 3.

Group B - Claims 2 -3.

Rejections Under 35 U.S.C., Section 102

The Examiner has rejected claims 1-3 under 35 U.S.C., Section 102(b) as being anticipated by Dvoracek.

The Examiner states that:

Dvoracek teaches a lid 10 having an annular clamp comprising an outer lip (unnumbered downwardly extending portion spaced radially inwardly from lip 28) to receive and “capture” the rim of a cup, a spout 24 extending upwardly from a top of the clamp to a

discharge port 26 at an apex thereof and being entirely above the clamp, the inner wall of the clamp and an inner wall of the spout converging smoothly to the discharge port (see figure 3). The lid of Dvoracek is disposable since it can and will be discarded upon the decision of the user to do so.

GROUP A

Claims 1-3 all require a clamp with lips for gripping both walls of the lip of the cup inserted therebetween.

Appellants submit that Dvoracek does not have a “clamp” as required by Appellants’ claims 1-3 and does not have “inner and outer lips to grip the inner and outer walls of the lip of a cup inserted therebetween” as required by Appellants’ claims. Dvoracek is a lid for a metal beverage container. It has a skirt 28 for interlocking the lid 10 to a ridge 32. The ridge 32 is said to be invariably formed by the crimping of the body 16 to the top 14 of the can 12 (Col.3, Ln.60-65). Dvoracek’s “interlocking” skirt does not “clamp” or “grip” as is evident from the further description given by Dvoracek. Dvoracek teaches that the inner surface of Dvoracek’s skirt 28 is tapered from the top and the bottom so as to form a narrowest diameter which is less than the outer diameter of the ridge 32 at about the mid elevation of the skirt 28. and a wider diameter at the top of the ridge 32 which exceeds the diameter of the ridge 32 (Col.3, Ln.68 – Col.4, Ln.5). Since the skirt 28 circles the entire can at a diameter less than the diameter of the ridge 32, the ridge 32 cannot slip out of the skirt 28. Consequently, the “geometry” is said by Dvoracek to “capture” the ridge 32 with the encircling skirt 28 (Col.4, Ln.12-14). Dvoracek’s “inner lip” (so designated by the Examiner) plays no part in securing Dvoracek’s lid to the ridge 32 of the metal can. Dvoracek never mentions the “inner lip” in describing the operation of a lid. Dvoracek’s Figure 3 is consistent with Dvoracek’s description. The skirt 28 “captures” the ridge 32 in its “geometry” because the skirt 28 surrounds the entire ridge and because the narrowest point on

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the skirt 28 is narrower than and extends under the ridge 32. Dvoracek defines the dimensions of the skirt 28 in relation to the dimension of the ridge 32. The diameter of the skirt exceeds the diameter of the crimped ridge. “Capturing” results because the lower diameter of the skirt slides under the ridge. The unidentified “inner lip” does not extend low enough to oppose the lower or narrower diameter of the skirt, as in Appellants’ lid, which is necessary if the cup wall is to be “gripped” therebetween.

There is no information in Dvoracek to suggest that the unidentified “inner lip” even touches the ridge 32, much less cooperates with the skirt 28 to “grip the inner and outer walls of the lip of a cup inserted therebetween.” Clamps compress an item held between their members to grip what is inserted therebetween. This is what is claimed by Appellants. Dvoracek teaches no clamp and does not operate as a clamp. Even the Examiner has refrained from using the claim word “grip” and has used the word “capture,” which is Dvoracek’s description of how that device works. Appellants’ outer lip does not “capture” the cup. It cooperates with inner lip to form a clamp to grip the wall of the cup. In receiving the Examiner’s earlier rejections of these claims under 35 U.S.C. § 103 as being unpatentable over Freeman in view of Meyers, the Board of Patent Appeals noted that “As there is nothing in Freeman’s disclosure which even remotely suggests that this ring cooperates with the peripheral lip to clamp the rim of the container, the Examiner’s position here is unsound.” There is nothing in Dvoracek to suggest such cooperation, either.

In defense of reliance on Dvoracek, the Examiner argues that “if the prior art structure is capable of performing the intended use, then it meets this claim.” But Dvoracek is only capable of “capturing” the crimped ridge invariably formed at the top of a can. It is not capable of “gripping the rim of a cup.”

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In further defense of reliance on Dvoracek, the Examiner argues that “while it is true that the lid of Dvoracek does not show the lid “gripping” the inner and outer walls of a cup, that does not preclude the inner and outer lips from doing so. Dvoracek does not merely fail to show “gripping.” It fails to teach it and affirmatively teaches to the contrary, that is, to “capture” and not to grip.

In the present rejection under 35 U.S.C. § 102 Dvoracek relies on the narrower diameter below the inner lip to “capture” the required crimped ridge. This is the key to Dvoracek’s operation. Dvoracek does not suggest any clamping or cooperation of inner and outer lips to grip the rim of a cup. The Examiner’s rejection of claims 1-3 (Group A) under 35 U.S.C. § 102 is unsound and should be reversed.

GROUP B

Claims 2 and 3 stand apart from claim 1 in that they further require: a “frustoconical” spout having a “truncation specifically formed in the shape of a “horizontal plane tangent to a bottom wall of a horizontal cylinder.”

The Examiner does not argue as to anticipation that Dvoracek teaches a “frustoconical” spout. The Examiner argues as to obviousness that “it would have been obvious” to make it frustoconical. This will not support a rejection of claims 2-3 under 35 U.S.C. § 102, and the rejection of claims 2 and 3 under 35 U.S.C. § 102 should also be reversed for this reason.

Rejections Under 35 U.S.C. 103

The Examiner rejects claims 2 and 3 under 35 U.S.C. 103 (a) as unpatentable over Dvoracek, arguing that modification of the spout of Dvoracek to be frustoconical is a mere change in shape.

The patent to Dvoracek was issued in 1990 and is noted by the Examiner to be in Classification 220/713. This is the same classification searched by the Examiner prior to the Office Action dated July 3, 2000 which eventually led to the first appeal in this case. Dvoracek is less pertinent than the art earlier used by the Examiner. Dvoracek does not relate to a lid which is attached to a cup but to a can having a ridge. The ridge, says Dvoracek, “invariably” results from crimping the top and side walls of the can. Without the ridge of the can, Dvoracek does not work. Dvoracek has nothing to do with gripping the rim of a cup as claimed by Appellants. There is nothing in Dvoracek to suggest such a use. There is no support for the Examiner’s conclusion in the fair teachings of Dvoracek. In fact, Dvoracek’s fair teachings of the manner of connection of the lid to the can are contrary to Appellants’ teachings. The incorrect conclusions of the Examiner respecting Dvoracek are totally unsupported and contradicted by Dvoracek and are based on the impermissible use of Appellants’ claims as a roadmap.

As to the Examiner’s statement that the frustoconical limitations of the claims are mere choices of shape, the claims have not changed since the first appeal. The Examiner made no such argument then. The Examiner’s argument based on prior art was rejected by the Board of Appeals. A frustoconical spout produces desirable flow results while other shapes do not necessarily do so. The choice of a “frustoconical” spout is not merely one of design but of resulting flow patterns (spec. p.6, ln.19-23). The Examiner is totally lacking in support for the conclusion of obviousness to one of ordinary skill in the art. This is a substantive, not a design, change and renders claims 2 and 3 patentable.

Claims 2 and 3 are patentable over Dvoracek and the rejection of claims 2 and 3 under 35 U.S.C. § 103 should be reversed.

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CONCLUSION

For the reasons stated above, Appellants' claimed device is not anticipated by or rendered obvious by this reference. Furthermore, the claims of Groups A (1-3) and B (2-3) are allowable for both their commonly applicable reasons and for their own unique reasons outlined above. Reversal of the rejection of all claims is respectfully requested.

VIII. CLAIMS APPENDIX (37 C.F.R. 41.37(c)(1)(viii))

The text of the claims involved in the appeal are:

1. A disposable lid for a cup comprising an annular clamp adapted to be seated on a rim of the cup, said clamp having inner and outer lips to grip inner and outer walls of a lip of the cup inserted therebetween and a spout extending upwardly from a top of said clamp to a discharge port at an apex thereof, an inner wall of said clamp and an inner wall of said spout converging smoothly to said discharge port, said spout being entirely above said clamp.

2. A disposable lid for a cup comprising an annular clamp adapted to be seated on a rim of the cup, said clamp having inner and outer lips to grip inner and outer walls of a lip of the cup inserted therebetween and a frustoconical spout extending upwardly from said rim to a discharge port at an apex thereof, said spout having a truncation in the shape of a horizontal plane tangent to a bottom wall of a horizontal cylinder and a base inside diameter equal to a top inside diameter of said clamp wherein an inner wall of said clamp and an inner wall of said spout converge smoothly to said discharge port.

3. A lid according to claim 2, said clamp comprising an annular rim having inner and outer edges and a bottom face adapted to be seated on a rim of the cup, an inner lip extending downwardly from said inner edge and an outer lip extending downwardly from said outer edge of said annular rim, said inner and outer lips being cooperable to grip a lip of the cup inserted therebetween.

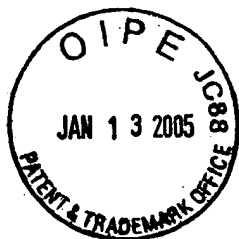
IX. EVIDENCE APPENDIX

Not applicable.

X. RELATED PROCEEDINGS APPENDIX

Attached find a copy of the Decision on Appeal mailed June 19, 2003, Appeal No. 2003-0107.

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.



Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JUN 19 2003
PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT C. HEATH
and JETT E. STUBBS

Appeal No. 2003-0107
Application No. 09/491,094

RECEIVED
JUN 23 2003

ON BRIEF

Before ABRAMS, McQUADE and NASE, Administrative Patent Judges.

By the Board

DECISION ON APPEAL

Robert C. Heath, et al. appeal from the final rejection (Paper No. 7) of claims 1 through 3.¹ Claims 4 through 10, the only other claims pending in the application, stand allowed.

THE INVENTION

The invention relates to "disposable lids for cups" (specification, page 1). Representative claims 1 and 2 read as follows:

¹ Claims 1 and 2 have been amended subsequent to final rejection.

1. A disposable lid for a cup comprising an annular clamp adapted to be seated on a rim of the cup, said clamp having inner and outer lips to grip inner and outer walls of a lip of the cup inserted therebetween and a spout extending upwardly from a tip of said clamp to a discharge port at an apex thereof, an inner wall of said clamp and an inner wall of said spout converging smoothly to said discharge port, said spout being entirely above said clamp.

2. A disposable lid for a cup comprising an annular clamp adapted to be seated on a rim of the cup, said clamp having inner and outer lips to grip inner and outer walls of a lip of the cup inserted therebetween and a frustoconical spout extending upwardly from said rim to a discharge port at an apex thereof, said spout having a truncation in the shape of a horizontal plane tangent to a bottom wall of a horizontal cylinder and a base inside diameter equal to a top inside diameter of said clamp wherein an inner wall of said clamp and an inner wall of said spout converge smoothly to said discharge port.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Meyers	4,953,737	Sep. 04, 1990
Freeman et al. (Freeman)	5,186,347	Feb. 16, 1993

THE REJECTION

Claims 1 through 3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Meyers.

Attention is directed to the appellants' main and reply briefs (Paper Nos. 11 and 13) and to the examiner's answer (Paper No. 12) for the respective positions of the appellants and the examiner regarding the merits of this rejection.

DISCUSSION

Freeman, the examiner's primary reference, discloses a closure or lid for a beverage container. The closure 10 has a depending peripheral lip for extending about, and attaching the lid to, the upper rim of the container (see Figures 2 and 5) and an upwardly projecting discharge spout 12 disposed entirely above the peripheral lip. Freeman conveys no detail as to the peripheral lip beyond that which is depicted in the drawings. The drawings (see Figures 2 and 5) also show the closure as having what appears to be a depending ring located radially inwardly of the peripheral lip for contacting the upper surface of the container rim.

The examiner concedes (see page 3 in the answer) that Freeman lacks response to the limitations in independent claims 1 and 2 requiring the inner walls of the clamp and spout to converge smoothly to the discharge port. Freeman's closure has no such smooth convergence.

The appellants submit that Freeman is further deficient with respect to the subject matter recited in claims 1 and 2 in that the lid disclosed in the reference lacks a clamp having an inner lip. According to the examiner (see pages 2 and 3 in the answer), the unidentified ring shown in Freeman's Figures 2 and 5 constitutes a clamp inner wall. As there is nothing in Freeman's disclosure which even remotely suggests that this ring cooperates

with the peripheral lip to clamp the rim of the container, the examiner's position here is unsound. Thus, Freeman also lacks response to the limitations in claims 1 and 2 requiring a clamp having an inner lip.

Meyers, the examiner's secondary reference, discloses a self-righting cup having a removable lid. As shown in Figures 5 and 6, the lid 45 includes an upwardly extending spout 46 and a downwardly opening groove 50 "which fits snugly over the rim 34 of the cup" (column 4, line 12). In the examiner's view, this structure is such that "an inner wall of the clamp and an inner wall of the discharge spout smoothly converge to a discharge port of the discharge spout" (answer, page 3).

In proposing to combine Freeman and Meyers to reject the appealed claims, the examiner concludes that

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of an inner wall of the clamp and an inner wall of the discharge spout smoothly converging to a discharge port of the spout as taught by Meyers to the lid of Freeman by moving the inner wall of the clamp radially inwardly until such convergence is met. Doing so would allow complete drainage and a smooth flow of fluid from the lid upon attachment to a liquid filled container.

Additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was made to extend the inner wall axially, downwardly to ensure it grips as [sic] significant portion of the inner wall of the associated cup rim. Doing so would ensure a tight seal between the cup lid and the associated container rim [answer, page 3].

These conclusions find no support in the fair teachings of Freeman and Meyers. As pointed out by the appellants, "Meyers does not teach or suggest the desirability or structure of a clamp inner wall which smoothly converges with a discharge port inner wall" (main brief, page 6). Figure 6 shows Meyers' inner clamp wall as being vertical and the adjoining spout wall as being inclined to vertical. There is nothing in the reference to indicate that these angulated surfaces converge smoothly. The examiner's finding to the contrary is unduly speculative. This shortcoming, coupled with Freeman's failure to teach a clamp with inner and outer lips, undermines the examiner's conclusion of obviousness. The only suggestion for combining Freeman and Meyers so as to arrive at the subject matter recited in claims 1 and 2 stems from hindsight knowledge impermissibly derived from the appellants' disclosure.

Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 1 and 2, and dependent claim 3, as being unpatentable over Freeman in view of Meyers.

Appeal No. 2003-0107
Application 09/491,094

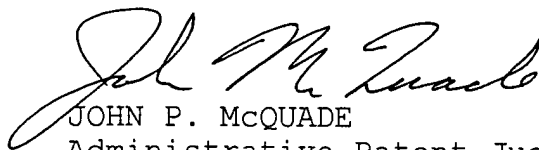
SUMMARY

The decision of the examiner to reject claims 1 through 3 is reversed.

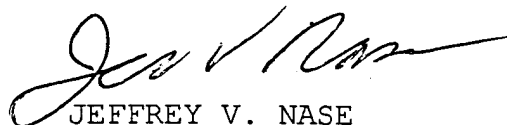
REVERSED



NEAL E. ABRAMS
Administrative Patent Judge



JOHN P. McQUADE
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge

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JPM/gjh

Appeal No. 2003-0107
Application 09/491,094

Frank J. Catalano
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Respectfully submitted,

 1/10/05
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